



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL NO.

ATTORNEY DOCKET NO. 428191

Applicant: Daniel M. Eggert and Frank Mikic
Title: MAGNETIC BIT HOLDER AND HAND TOOL
INCORPORATING SAME
Serial No.: 09/110,145
Filing Date: July 2, 1998
Group Art Unit: 3723
Examiner: D.S. Meislin
Date: June 28, 2000

BRIEF ON APPEAL

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This is an appeal from the decision of the Primary Examiner, dated February 9, 2000, finally rejecting claims 15-22.

REAL PARTY IN INTEREST

This application is assigned to Snap-on Technologies, Inc. ("Snap-on"), the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-22 are pending in the application. Claims 1-14 stand allowed.

Claims 15-22 are finally rejected, are appealed and are set forth in Appendix A.

STATUS OF AMENDMENTS

All amendments have been entered. There are no amendments subsequent to the final rejection.

SUMMARY OF INVENTION

The claimed invention is a bit holder 20 for a hand tool, which may be in the nature of a screwdriver (Fig. 1). The bit holder 20 includes a cylindrical body 21 having a distal end surface 22 in which is formed an axial bore 23 (Fig. 2), which terminates at an inner end surface 24. A permanent magnet 25 (column 1, line 53) is received in the bore 23 and is retained in place by a discrete retaining member.

In Figs. 2 and 3, there is illustrated a first embodiment 26 of the retaining member, which is in the shape of a flat, circular disk (column 3, lines 2-3). Another embodiment, shown in Figs. 4-6, is a retaining member 35, which is circular and generally bowl-shaped, with its convex side

facing the magnet 25 (column 3, lines 35-39). Each of the retaining members 26 and 35 is friction fitted in the bore (column 3, lines 3-4 and 40) outboard of the magnet 25, so as to substantially cover the outer or forwardmost surface of the magnet 25 (Figs. 2 and 6)

The bore 23 is hexagonal in transverse cross section (Fig. 3 and column 2, lines 51-52) and the portion thereof outboard of the retaining member 26 or 35 defines a socket or cavity for receiving an associated bit 30 (Fig. 2 and column 3, lines 17-18).

PROSECUTION HISTORY

The final rejection is based on alleged improper recapture of previously surrendered subject matter under 35 U.S.C. § 251 and, therefore, the prosecution history, including prior applications, is relevant.

This is an application for reissue of U.S. patent no. 5,577,426 ("the original patent"), which matured from application serial no. 08/335,992 ("the original application"). As filed, the original application included an independent claim 1, set forth in Appendix B, which was generic to both the flat and bowl-shaped retaining member embodiments. It recited the retaining member broadly as:

"retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore"

Claim 6, also set forth in Appendix B, was dependent on claim 1 (via claims 3 and 4), and was specific to the embodiment of Figs. 4 and 5, stating that "said retaining member is generally bowl-shaped, being convex toward said magnet."

Claims 1, 3, and 4 were all rejected as being unpatentable over patent no. 4,663,998 to Parsons et al., in view of secondary references. Parsons et al. discloses a split-ring magnet retainer in a wrench socket. Claim 6 was not rejected on the basis of the prior art. After a first amendment of claim 1 was finally rejected on the basis of the same art applied in the first action, claim 1 was then amended to add the subject matter of claim 6, by reciting the “retaining member being generally bowl-shaped and convex towards said magnet,” whereupon claim 1 was allowed and became claim 1 of the original patent.

Claims to the flat embodiment of Figs. 2 and 3 were pursued in a divisional application serial no. 08/593,396, now U.S. patent no. 5, 603, 248.

ISSUE

The issue presented for review is whether claims 15-22, by failing to include the limitation “retaining member being generally bowl-shaped and convex toward said magnet”, constitute an improper attempt to recapture subject matter surrendered in the original application, under 35 U.S.C. § 251.

GROUPING OF CLAIMS

Claims 15-22 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. As to this rejection, claims 15-21 will stand or fall together, and claim 22 will be separated argued.

ARGUMENT

I. The Recapture Rule Does Not Bar Claims 15-22, Because they Are Materially Narrower than Any Claim in the Original Application.

Under 35 U.S.C. § 251, a reissue of a patent may be permitted when the patent is, “through error without any deceptive intention,” deemed to be wholly or partly inoperative or invalid by reason of the patentee claiming “less than he had a right to claim in the patent” A deliberate cancellation or amendment of a claim may not be the type of “error” contemplated by the statute and, if so, the canceled or amended subject matter may not be “recaptured” by reissue.¹

The CAFC has held that:

“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application (emphasis in original).²

Thus, the recapture rule does not apply when the reissue claims are narrower in a material respect than the canceled claims, even though they may be broader in other respects.³

In the final rejection, the examiner states that she “prefers to not cloud the issue by discussing whether a claim which omits one limitation and adds another limitation should be construed as being a ‘broader or narrower claim.’” However, it is not necessary that the reissue

¹ *Ball Corp. v. United States*, 221 U.S.P.Q. 289, 294 (Fed. Cir. 1984).

² *Id.* at 295.

³ *Id.* at 295-296; in re *Clement*, 45 U.S.P.Q. 2d 1161, 1165 (Fed. Cir. 1997); *Hester Industries, Inc. v. Stein, Inc.*, 46 U.S.P.Q. 2d 1641, 1649-1650 (Fed. Cir. 1998).

claim, as a whole, be characterized as either “broader” or “narrower” than another claim. Rather, the CAFC’s decision in *In re Clement* specifically addresses the situation of the present case, wherein the reissue claim is both broader and narrower, i.e., “broader in some respects, but narrower in others,” than claims canceled from the original application.⁴ In that situation, the court held that:

If the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim ...”⁵

Claim 15 on appeal is set forth in Appendix A, and claim 1 of the original application is set forth in Appendix B. Comparing these claims, claim 15 is broader in that it lacks the limitations that the body is “cylindrical”, that the bore is “axial” and “terminating in an inner end surface,” that the magnet is “permanent,” that the retaining structure is “in contact with” the magnet and that the bit-receiving socket is “non-circular” in transverse cross section. None of these limitations is germane to the prior art rejection, since none serves to distinguish over Parsons et al. and none was ever relied upon to distinguish over the prior art. Furthermore, claim 15 on appeal, which lacks any the above-listed limitations, is **not** rejected on the basis of prior art. Clearly, the presence or absence of these limitations is not relevant to the prior art rejection.

However, claim 15 is narrower than claim 1 of the original application in a significant respect, in that it specifies that the retaining member is “substantially covering said outer surface of said magnet.” This limitation is germane to the prior art rejection on the basis of the Parsons

⁴ 45 U.S.P.Q. 2d at 1165.

⁵ *Id.*

et al. patent no. 4,663,998, in that it serves to distinguish from that reference, which discloses a split-ring retainer.

Thus, claim 15 is not of the same or broader⁶ scope than claims canceled from the original application, but is rather narrower in scope in a material respect. Accordingly, for this reason, the recapture rule does not apply to claim 15 and, *a fortiori*, does not apply to claims 16-21 dependent on claim 15.

Claim 22 is identical to claim 15, with the exception that the limitation “substantially covering said outer surface of said magnet” has been replaced with a limitation that the retaining member has “a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery.” This limitation is also germane to the prior art rejection on the basis of the Parsons et al. patent, in that it serves to distinguish from the split-ring retainer disclosed in that reference. Thus, claim 22 is also narrower in scope in a material respect than claims canceled from the original application and, therefore, the recapture rule does not apply to claim 22.

II. The Subject Matter of Claims 15-22 Was Not “Surrendered” in the Original Application.

The rejection is based on the absence from the reissue claims 15-22 of the limitation “retaining member generally bowl-shaped and convex toward said magnet,” which was added by

⁶ Note that in the *Ball* case the CAFC specifically held that the principle that a reissue claim broader in any respect than the original patent claims is broader, even though it may be narrower in other respects, which is applied for determining applicability of the 2-year limitation for broadened reissues, is not applicable relative to the recapture rule (221 U.S.P.Q. at 295-296).

amendment to claims in the original application. Thus, the examiner's position is based on the assumption that applicants surrendered all retaining members except those which are "generally bowl-shaped and convex toward said magnet." But the scope of the subject matter surrendered cannot be determined by simply looking at the language of the limitations added to the claim. Rather, one must look also to the language of the claim **before amendment** and to the scope of the prior art being distinguished. The reason why amendment of a claim to overcome a reference is relevant, is that it constitutes evidence "that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable."⁷ Claim 1 of the original application, before amendment by addition of the "bowl-shaped and convex" language, was silent as to the size or shape of the retaining member. **That**, i.e., a retaining member unlimited as to size or shape, is the subject matter which was surrendered, and applicants are making no attempt in this reissue application to recapture that subject matter.

Amendment of claim 1 was necessary because the prior art included a retaining member having a particular size and shape, i.e., the split-ring retainer of Parsons et al. There are various ways to distinguish from that reference. One was by addition of the "bowl-shaped and convex" language added in the original application, and which was ultimately allowed. Another was recitation of a "discrete, flat, imperforate retaining member," as in the divisional application, which was also allowed. A third approach is that pursued in rejected claim 15 herein, which recites a retaining member "substantially covering said outer surface of said magnet." A fourth

⁷ In re *Clement*, 45 U.S.P.Q. 2d at 1164.

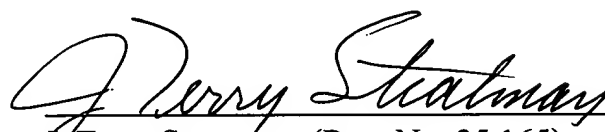
approach is that pursued in rejected claim 22, which recites a retaining member “having a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery.” It is clear from the foregoing that applicants did not surrender all retaining members which were not “bowl-shaped and convex toward said magnet.” Rather, applicants surrendered only the specific split-ring retaining member shape of Parsons et al. and the claim scope before it was amended, i.e., a retaining member unlimited as to size and shape. Applicants’ amendment to overcome the rejection constituted evidence that those subjects matter were surrendered as unpatentable, but neither of those subjects matter is being pursued in this reissue application. The amendment did not constitute a surrender of the subject matter of claims 15-22 and, therefore, the recapture rule does not afford a valid basis for rejection of those claims.

This result is entirely sensible. The recapture rule is intended to prevent an applicant from having his cake and eating it too, by giving up a claim scope in the face of a rejection and then, by reissue, trying to again pursue the same claim scope. However, as long as an applicant is not attempting to resurrect in reissue a claim scope which was effectively canceled in the original application, and otherwise adheres to the reissue rules, there is no reason why he should not be able to pursue any claim supported by the original disclosure which distinguishes from the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the rejection of claims 15-22 on the basis of the recapture rule is in error and should be reversed.

Respectfully submitted,



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Harold V. Stotland (Reg. No. 24,492)

APPENDIX B

1. A bit holder comprising: a cylindrical body having a distal end surface and an axis, said body having formed in said end surface an axial bore terminating at an inner end surface, a permanent magnet received in said bore and having an outer surface, and retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore, said bore having a portion of non-circular transverse cross section outboard of said retaining structure defining a bit-receiving socket.

3. The bit holder of claim 1, wherein said magnet has a transverse cross-sectional size smaller than the cross-sectional size of said bore so as to be freely receivable in said bore.

4. The bit holder of claim 3, wherein said retaining structure includes a retaining member mounted in said bore outboard of said magnet for cooperation with said inner end surface to retain said magnet therebetween.

6. The bit holder of claim 4, wherein said retaining member is generally bowl-shaped, being convex toward said magnet.

APPENDIX A

15. A bit holder comprising:
 - a body having a distal end surface,
 - said body having a bore formed in said end surface,
 - a magnet received in said bore and having an outer surface,
 - and a discrete retaining member friction fitted in said bore outboard of said magnet and substantially covering said outer surface of said magnet to retain said magnet in said bore,
 - said bore having a portion outboard of said retaining member defining a bit-receiving socket.
16. The bit holder of claim 15, wherein said magnet is a permanent magnet.
17. The bit holder of claim 15, wherein the portion of said bore outboard of said retaining member is non-circular in transverse cross section.
18. The bit holder of claim 15, wherein said retaining member is generally bowl-shaped and convex toward said magnet.
19. The bit holder of claim 15, wherein said body has an axis of rotation extending through said end surface, said bore being formed axially in said end surface.

20. The bit holder of claim 15, wherein said bore terminates at an inner end surface, said retaining member cooperating with said inner end surface to retain said magnet therebetween.

21. The bit holder of claim 15, wherein said retaining member is a substantially circular disk.

22. A bit holder comprising:
a body having a distal end surface,
said body having a bore formed in said end surface,
a magnet received in said bore and having an outer surface,
and a discrete retaining member friction fitted in said bore outboard of said magnet to retain said magnet in said bore,
said retaining member having a continuous outer periphery such that any two points on the periphery can be joined by a straight line segment which does not extend outside the periphery,
said bore having a portion outboard of said retaining member defining a bit-receiving socket.